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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/742,803 | 12/19/2000 | Gary R. McLuen | NEI-00104 | 7285 |

28960 7590 03/04/2010
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REC'D MAR 08 2010

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| EXAMINER |
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HANDY, DWAYNE K

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| ART UNIT | PAPER NUMBER |
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1797

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| MAIL DATE | DELIVERY MODE |
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03/04/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/742,803

Applicant(s)

MCLUEN ET AL.

Examiner

DWAYNE K. HANDY

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-30, 35-38, 40, 42, 44-48 and 50-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-30, 35-38, 40, 42, 44-48 and 50-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12/10/09 have been fully considered. Applicant has amended independent claims 29, 35, 36, 45-48, 50-53, 56 and 59-61 to recite the additional limitation of either an interior or outer wall that linearly tapers from the top opening or support to the bottom opening or frit. The Examiner has interpreted the new limitations to require an inner or outer wall that linearly tapers inward to yield a smaller dimension inside the vial for holding the frit. See Figure 6 of Applicant's disclosure. These new limitations are sufficient to overcome the previous 102 rejections of claims 29, 35, 36, 45-48, 50-53, 56 and 59-60 under the McGraw, Zuckerman and Cargill references. The Examiner has provided new 103 rejections in Paragraphs 10-12 below in response to the Amendments.

2. The Examiner has removed the previous 112 rejections in response to Applicant's amending of claim 61.

3. The Examiner notes that the previous 102 rejections of claims 27-28 under McGraw, Zuckerman and Cargill remain in effect. Claim 27 has not been amended.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 27 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by McGraw et al. (5,368,823).

6. Claims 27 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Zuckerman et al. (5,240,680).

7. Claims 27 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Cargill et al. (5,609,826).

These rejections were maintained in the previous Office Action (mailed 09/18/09). They remain in effect for the reasons given in previous Office Actions.

Inventorship

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 27-29, 35-38, 40-42, 44, 52 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGraw et al. (5,368,823). The Examiner believes Applicant is familiar with the McGraw reference. McGraw teaches every element of claims 27-29, 35-38, 40-42, 44, 52 and 61 except for an inner or outer wall that tapers from the from the top opening or support to the bottom opening or frit. The Examiner takes the position that the difference between the prior art and the instant device is one of shape. McGraw teaches a vial having a tapering surface with a different shape than the tapered surface and vial of instant claims (See Figure 6), but still provides the same function – retaining a solid support and frit on a narrowed portion inside the vial. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (The court held that the configuration of the claimed disposable plastic nursing container was a **matter of choice which a**

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person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.) See MPEP 2144.04, Section IV, B – “Changes in Shape”.

11. Claims 27-29, 35, 36, 38, 45-48, 50-54, 56, 57 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zuckerman et al. (5,240,680). The Examiner believes Applicant is familiar with the Zuckerman reference. Zuckerman teaches every element of claims 27-29, 35, 36, 38, 45-48, 50-54, 56, 57 and 61 except for an inner or outer wall that tapers from the from the top opening or support to the bottom opening or frit. The Examiner takes the position that the difference between the prior art and the instant device is one of shape. Zuckerman teaches a vial having a tapering surface with a different shape than the tapered surface and vial of instant claims (See Figure 3), but Zuckerman still provides the same function – retaining a solid support and frit on a narrowed portion inside the vial. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (The court held that the configuration of the claimed disposable plastic nursing container was a **matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.**) See MPEP 2144.04, Section IV, B – “Changes in Shape”.

12. Claims 27-30, 35, 36, 38, 45-48 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cargill et al. (5,609,826). The Examiner believes Applicant is

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familiar with the Cargill reference. Cargill teaches every element of claims 27-30, 35, 36, 38, 45-48 and 50-61 except for an inner or outer wall that tapers from the top opening or support to the bottom opening or frit. The Examiner takes the position that the difference between the prior art and the instant device is one of shape. Cargill teaches a vial having a tapering surface with a different shape than the tapered surface and vial of instant claims (See Figure 2A), but Cargill still provides the same function – retaining a solid support and frit on a narrowed portion inside the vial. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (The court held that the configuration of the claimed disposable plastic nursing container was a **matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.**) See MPEP 2144.04, Section IV, B – “Changes in Shape”.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DWAYNE K. HANDY whose telephone number is (571)272-1259. The examiner can normally be reached on M-F 11:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dwayne K Handy/
Examiner, Art Unit 1797
February 27, 2010

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797